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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) Raines-003	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _4-18-06_ Signature _Mary Shaver_ Typed or printed name _Mary Shaver_	Application Number 10/628,819	Filed 07/28/2003
	First Named Inventor Walter L. Raines	
	Art Unit 3624	Examiner Lalita M. Hamilton

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record. Registration number _34,399_

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature _Kenneth L. Nash_

Typed or printed name Kenneth L. Nash

Telephone number 281-583-1024

Date _4/18/06_

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1 and 16.

Claims 1 and 16 stand rejected under 35 USC 102(b) as anticipated by Ballard (US 6,032,137)

Respectfully, the Examiner has omitted two essential elements required in claims 1 and 16, as well as other elements discussed herein briefly.

The Examiner asserts that the first of the missing elements is shown in a cited passage, which Applicant submits is clearly not true.

The Examiner does not appear to have made an attempt to locate the second element in Ballard, and does not mention it in the rejection.

Essential Missing Element 1 from Claims 1 and 16.

It will be seen that Claims 1 and 16 each require a receipt with human readable text comprising at least the purchase price and date, Moreover, Claims 1 and 16 require separately positioned machine readable data on the receipt that must include at least the purchase price, the date of purchase, and the credit card number. This element is omitted.

The Examiner cites to Figure 3B of Ballard and to Ballard Col. 5, line 64- Col. 6, line 28 to show this element. The Examiner is correct that Figure 3B shows human readable text and separately positioned machine readable data, namely "glyphs" or "dataglyphs." However, the Examiner is incorrect in stating that this passage says the machine readable data in the "glyphs" include purchase price, data, and credit card number.

Applicant's understanding is that the function of the glyphs in Ballard is to provide partition or formatting information for the wide range of different types of documents,

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which the Ballard system is intended to process.   Most likely, the glyphs are pre-printed on a roll of paper for receipts or on other specific types of documents, and therefore could not possibly contain specific transaction information. In no instance does Ballard ever teach that the glyphs are used to provide specific information in any type of document, much less the specific information found in a credit card receipt, as required by Applicant's invention.

The passage cited in the Office Action mainly explains what a Xerox "dataglyph" (shown in Fig. 3B) is and states that the glyphs can contain "large amounts of information." The same cited passage at Col. 6, lines 13-23 also states the glyphs include "error correction codes," not information from any specific ticket. The cited passage does not say what type of error correction codes are actually included in the glyphs. However, Ballard goes on to discuss error correction by operators who more quickly locate information for a particular type of document in specific fields or snippets based on a "template", which apparently must be found in the glyphs. See Col. 15, lines 40-43; Col. 20, line 56-67.

Unequivocally, the cited passage does not say that the machine-readable data comprises the purchase price, credit card number, and date as required by the claims. The Examiner clearly has not established a prima facia case.

While Ballard does not specifically explain how the glyphs are produced, it is likely that the receipts are pre-printed to include the glyphs, because the only apparent purpose of the glyphs is to provide "template" information for a particular type of document. If pre-printed, the glyphs could not possibly contain the information in the ticket, as required by Applicant. Note that claim 16 also requires programming to produce a ticket wherein the required information is in the machine-readable data. Ballard clearly does not show programming a printer to produce a ticket in this way.

The Examiner apparently misunderstood the basic purpose of Ballard, which is to process many different types of documents (Col. 3, lines 37-43), and incorrectly believed, without

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support, that because Ballard shows a ticket with a glyph, that the glyph must necessarily include the information needed for Applicant's process. Ballard plainly does not say this.

As understood, Ballard teaches that the glyph contains a "template" with the location of the "fields" or subdivisions into which any document, such as a receipt, might be partitioned. For instance, in Col. 11, lines 8-10, Ballard states the glyph may be used to identify the location of the signature on the receipt. The location of the fields or template on the ticket is also discussed beginning in Col. 9, line 43-Col. 10, line 18 where each portion of the ticket is broken into "fields." According to Ballard, when the "snippets" of the ticket as defined by the "fields" are subsequently processed to extract data, the data is then more quickly and accurately located utilizing a "template" for the bit image of the ticket. See Col. 20, line 56-67. Ballard does not perform OCR (optical character recognition) of human readable text on site, but simply forms a bit image (See Fig. 3a "Bit Image of Scanned Credit Slips" and Col. 5, line 52-54, Col. 7, lines 59-Col. 8, line 51).

Ballard's ISDATA (Image Snippet Derived Data Record), discussed at Col. 20, lines 56-67, is the actual source of the data in the fields derived from the ticket or some other document, not the glyphs. Apparently, Ballard prefers to use higher speed computers to perform the more intense processing requirements of OCR at a central location 600. By using "snippets," Ballard also describes how only a portion of a document containing an error is sent to an operator who can "quickly recognize and correct the error" Col. 15, lines 51-52; Col.11, lines 1-2. Thus, Ballard apparently uses the glyphs to include partitioning or formatting information for a wide range of different documents, which Ballard intends to process to improve human error correction. Ballard hopes to significantly improve any required correction by requiring only that the snippet be sent to the operator for reading and correction. Col. 15, lines 35-43.

Therefore, the Office Action completely mischaracterizes the cited passage as saying the glyphs include "the information on the receipt". To establish anticipation, "The identical invention must be shown....The prior art must be enabling" Ballard does not show the

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identical invention. <u>Clearly, Ballard is not enabling of Applicant's invention and does not conceive of using the glyph for the purpose of applicant.</u>

In fact, for Applicant's purposes, a bar code is preferred, because very little data is needed, and because a bar code can be produced with sufficient accuracy using inexpensive impact printers that are most frequently used by merchants. Even bar codes produced with <u>partially malfunctioning</u> impact printers can normally be accurately and reliably read. On the other hand, <u>there is no reason to believe that the device of Ballard could operate using bar codes, as specifically required in claim 2, because bar codes do not contain sufficient information necessary to provide a template for a document.</u>

Essential Missing Element 2 from claims 1 and 16.

Applicant requires storing the electronic representation of the ticket using the recognized machine-readable data, specifically the recognized machine-readable data that includes the credit card number, purchase price and date. <u>Ballard does not say this.</u> <u>Ballard states that the glyphs contain "error correction codes," not specific data on the ticket, which is used for organizing the receipt information for retrieval.</u>

In fact, Ballard clearly states that the glyph <u>may or may not be readable</u>. Col. 11, lines 4-5. If the glyph is not readable, then it could not be used as taught by Applicant, because the claim states the receipts are indexed using the recognized machine-readable data.

In Ballard's explanation of storing data on documents, Ballard appears to be storing data based on the user's name, and perhaps the date the batch of documents was processed. Col. 17, line 25 – Col. 19, line 30. <u>There is nothing in Ballard that says that Ballard intends to recognize the machine-readable information, and use the recognized information for organizing the data for electronic retrieval.</u> <u>Thus, the second element is also omitted. The Office Action neglects to discuss this omitted element at all.</u>

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Accordingly, the Office Action clearly and indisputably fails to support a prima facia rejection under 35 USC 102(b) because at least two elements, if not more, are omitted.

Independent Claim 7 and other claims stand rejected under 35 USC 103 over Ballard in light of Cruse (US2002/0010659). No motivation – omitted element.

Cruse is not aware of the problem of chargebacks and has nothing to do with credit cards, but instead shows receipts for inventory refill requests made by employees with IDs. Contrary to the Office Action (p. 4 last paragraph), Cruse does <u>not</u> permit others to view an image of a paper receipt with a signature as required by claim 7 in the first limitation. Cruse simply allows viewing the information, not the actual receipts. There is no reason to make such proof because verification is based on IDs. No signatures are used, so there are no signatures to verify. Cruse does <u>not</u> scan the receipt to keep an image of the receipt or of any endorsement. Instead, Cruse teaches that a bar code is scanned at the inventory bin as shown in Fig. 2 to generate an order for refilling the inventory. Accordingly, even in combination with Ballard, contrary to the Office Action, Cruse does not show a system that permits others to view an image of a paper receipt with a signature.

Contrary to the Office Action, there is no motivation for Cruse to use Ballard's OCR, as proposed in the Office Action (p. 3, last paragraph), due to the well-known inevitability of OCR errors. OCR costs more and is known to create errors. Therefore, the proposed modification is not logical, and is completely arbitrary with no practical purpose. Why pay more just to get errors? The rejection is a classic example of where an Applicant's claims have been improperly used as a patent search "shopping cart" to randomly pick and choose from the prior art. "It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)."